

# UNITED STATES PATENT AND TRADEMARK OFFICE

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**U. S. REGISTRATION NUMBER:**



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**MARK:**

GRAIN AUDIO

**ISSUE/MAILING DATE:**

March 7, 2014

**APPLICANT/REGISTRANT:**

Grain Audio, LLC

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

120331

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## PETITION TO DIRECTOR DENIED

Grain Audio, LLC (petitioner) has petitioned the Director of the United States Patent and Trademark Office (Director) to reopen prosecution of the above-referenced application pursuant to Trademark Rule 2.142(g). 37 C.F.R. §2.142(g). The petition is denied.

### FACTS<sup>1</sup>

On November 22, 2013, the Trademark Trial and Appeal Board (TTAB) sustained the refusal to register petitioner's mark under Trademark Act Section 2(d) because of a likelihood of confusion with U.S. Registration No. 2966216. 15 U.S.C. 1052(d). On January 21, 2014, petitioner filed this unverified petition<sup>2</sup> to the Director to reopen prosecution. Petitioner seeks to reopen prosecution to amend the identification of goods in order to obviate the likelihood of confusion refusal.

### DISCUSSION

A petition to the Director to reopen prosecution of an application after a decision by the TTAB will be considered only upon a showing of sufficient cause for consideration of any matter not already adjudicated. 37 C.F.R. 2.142(g). For example, a petition to reopen prosecution of an application could be granted if the appeal

<sup>1</sup> This decision recites only the facts relevant to the issue on petition.

<sup>2</sup> All facts to be proved on petition must be verified with a signed declaration under 37 C.F.R. §2.20. TMEP §1705.03.

involved the applicant's compliance with a requirement, rather than a refusal based on the nature of the mark, and compliance would place the application in condition for publication of the mark. *See In re Hickory Mfg. Co.*, 183 USPQ 789 (Comm'r Pats. 1974). However, a petition to reopen prosecution will be denied if granting the petition would require further examination. *See In re Petite Suites, Inc.*, 21 USPQ2d 1708 (Comm'r Pats. 1991); *In re Vycom Electronics Ltd.*, 21 USPQ2d 1799 (Comm'r Pats. 1986); *In re Mack Trucks, Inc.*, 189 USPQ 642 (Comm'r Pats. 1976); TMEP §1501.06. This rule promotes order and efficiency in the agency review process, ensuring that applicants provide relevant evidence and raise relevant issues prior to the resolution of the case before the TTAB.

#### *Petitioner's Proposed Amendment Would Require Further Examination*

In this case, the appeal involved a substantive refusal rather than compliance with a requirement. Specifically, registration was refused based on a likelihood of confusion with the mark in U.S. Registration No. 2966216 under Trademark Act Section 2(d). 15 U.S.C. §1052(d). After the TTAB issued a final decision affirming this refusal, petitioner filed the instant petition seeking to reopen prosecution so that it may amend the identification of goods.

Petitioner cites *In re Hickory* in support of its request, arguing that the examining attorney need only perform an updating search in order to place the application in condition for publication. (Petition 5). In *In re Hickory*, sufficient cause to reopen prosecution was measured against a consideration of further examination which might be required by the assigned examining attorney. The petitioner sought to enter a disclaimer statement, which was the only requirement in the final Office action, affirmed by the TTAB. Therefore, in that case, entering the amendment did place the application in condition for publication, without requiring any further examination on the part of the examining attorney. *See In re Hickory*, 183 USPQ at 789-790. However, in the present case, petitioner is requesting that the examining attorney consider its proposed identification of goods amendment. A change in the identification of goods, not previously considered by the examining attorney, could require a new search of the USPTO records or further research regarding relatedness of the goods in order to determine whether or not the amendment would obviate the outstanding likelihood of confusion refusal. Thus, "[t]he reexamination which might be involved in this case clearly exceeds an updating search." *In re Mack Trucks*, 189 USPQ at 643.

Therefore, prosecution will not be reopened to consider the identification of goods amendment because it would require further examination. *See* 37 C.F.R. 2.142(g); *TTAB Manual of Procedure* (TBMP) §1218.

#### *Proposed Amendment Does Not Place Application in Condition for Publication*

Moreover, petitioner's proposed amendment does not appear to obviate the likelihood of confusion refusal. Petitioner argues that it has removed all likelihood of confusion with the cited registration by deleting the goods "audio receivers," which were found "legally identical" to the registrant's "transmitters and receivers for telecommunications, namely, radio transmitters, audio receivers" by the TTAB. (Petition 3-4). Petitioner further contends that the deletion of the goods "audio amplifiers, audio receivers, audio mixers, audio decoders, speakers, compact disc players, MP3 controllers, MP3 players, microphones, audio speakers in the nature of music studio monitors . . . audio recording equipment, namely audio recorders, digital LP converters, wireless speakers, wireless audio players, portable audio players, portable speakers . . . powered speakers" removes all likelihood of confusion with the "computer peripherals" identified in the cited registration. (Petition 4).

The final Section 2(d) refusal issued by the examining attorney was not a partial refusal, applying only to the goods noted above. The final refusal applied to *all* of petitioner's identified goods, including the "audio speakers, phonographic record players, and bookshelf speakers" which would remain if petitioner's proposed amendment were accepted. In the final Office action dated November 6, 2012, the examining attorney specified that registrant's "computer peripherals" encompass speakers and provided third party website evidence showing that audio speakers are common computer peripherals. Petitioner's remaining "audio speakers" is worded broadly enough to include audio speakers used with computers, and would still be encompassed by the registrant's "computer peripherals."

Petitioner did not amend its identification of goods prior to the TTAB issuing its final decision, but instead chose to proceed without this amendment. Petitioner thus assumed the risk of an adverse decision by the examining attorney and the TTAB. Therefore, petitioner has not established sufficient cause to reopen prosecution. *See In re Mack Trucks*, 189 USPQ at 642-643.

## **DECISION**

The petition is denied. Petitioner is not without a remedy. Petitioner may file a new application for registration. A trademark application can be filed online via the Trademark Electronic Application System (TEAS) at [http://www.uspto.gov/trademarks/teas/initial\\_app.jsp](http://www.uspto.gov/trademarks/teas/initial_app.jsp).

/Sharon R. Marsh/

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Trademark Examination Policy

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